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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,776	06/18/2001	Pavitra Subramaniam	5306P034	2438

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EXAMINER

LU, KUEN S

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/883,776

Applicant(s)

SUBRAMANIAM ET AL.

Examiner

Kuen S Lu

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-13,15-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-13,15-23,25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Response to Amendments**

1. The Examiner acknowledged and considered the Applicants' Amendments to the Abstract filed on April 8, 2004.
2. In responding to Applicants' Amendments made to the claims, filed on April 8, 2004, the Examiner has created this Office Action for Final Rejection as shown next.
3. As for the Applicants' Remarks/Arguments, filed on April 8, 2004, has been fully considered by the Examiner, please see discussion in the section **Response to Arguments**, following the Office Action for Final Rejection.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, 7-9, 11-13, 15, 17-19, 21-23, 25 and 27-29 are rejected under 35 U.S.C. 102(e) as anticipated by Bouchard et al. (U.S. Patent 6,334,124, hereafter "Bouchard").

As per independent claims 1, 11 and 21, Bouchard teaches the following:

"configuring search indices on a server, the search indices being associated with corresponding business components" at col. 3, lines 11-17 by a user conducting a

keyword search for a keyword or subject and be furnished by server computer with a list of containing record references to the records that satisfy the search criteria;

“displaying the search indices to a client, the client being connected to the server via a computer network and being configured to perform search using data records stored on the client” by client computer on network (Fig. 2, elements 204-208) to conduct an index search (Fig. 3, elements 308-314, col. 9, lines 10-19) through the locally cached indices (col. 4, lines 49-52) for obtaining a search result locally;

“providing the client with a mechanism to individually select the one or more selected search indices for download onto the client” at Fig. 3, element 306, col. 9, lines 1-6 by transmitting client indices to the client computer; and

“downloading the one or more selected search indices from the server onto the client in response to the client's request to download the the one or more selected search indices to be used for searching on the client” at Fig. 3, elements 302-308, col. 8, lines 16-18 by transmitting client indices from the server to the client computers.

As per claims 2, 12 and 22, Bouchard teaches “each search index is associated to a corresponding search category” at col. 3, lines 8-17 by predefining search keys as keywords or subjects.

As per claims 3, 13 and 23, Bouchard teaches “displaying a list of search categories that are associated to the search indices” at col. 7, lines 34-40 by associating server indices with server data repository.

As per claims 5, 15 and 25, Bouchard teaches “performing a database synchronization operation to download index files containing search indices as

attachments onto the client” at col. 6, lines 56-64 by supplying the client computer with search indices and updating the indices as time goes by.

As per claims 7, 17 and 27, Bouchard teaches “each search index is represented by a corresponding search index object which includes an index identifier and a business component identifier of a specific business component to which the respective search index is associated” at col. 7, lines 34-40 by associating server indices with server data repository and col. 3, lines 8-11, by predefining keywords or subjects as search indices.

As per claims 8, 18 and 28, Bouchard teaches “defining a search index object for each business component that needs to be indexed by a search engine” at col. 3, lines 8-11, by predefining keywords or subjects as search indices; and

“associating the respective search index object to the corresponding business component” at col. 7, lines 34-40 by associating server indices with server data repository and col. 3, lines 8-11, by predefining keywords or subjects as search indices.

As per claims 9, 19 and 29, Bouchard teaches “search index related information including index identifier and search engine identifier are stored in a first table and search index related file attachments are stored in a second table” at col. 6, lines 56-64 by the cooperation between server and client computers to maintain and update client indices at the client computers.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2177

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 6, 10, 16, 20, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouchard et al. (U.S. Patent 6,334,124), as applied to Claims 1-3, 5, 7-9, 11-13, 15, 17-19, 21-23, 25 and 27-29 above, and further in view of Mao et al. (U.S. Patent 6,546,385, hereafter "Mao").

As per claims 6, 16 and 26, Bouchard teaches transmitting search indices from the server to the client computer at col. 9, lines 1-9.

Bouchard does not teach "performing an uncompress operation to uncompress the index files downloaded from the server into a specific directory on the client".

However, Mao teaches compressing and decompressing index at col. 2, lines 31-36 and downloading index from server to user's computing device at col. 2, lines 37-45.

It would have been obvious to one having ordinary skill in the art at the time of the Applicants' invention was made to combine Mao's teaching into Bouchard's by enhancing Bouchard's system with functionality of compressing and decompressing search indices because by doing so the client computer could be hand-held system for more feasible to perform more exhaustive searching of hardcopy documents.

As per claims 10, 20 and 30, Mao further teaches "marking associated index attachment files to be downloaded in response to the client's request for a database synchronization operation" at col. 2, lines 31-36 and 37-45 by using compressing and decompressing techniques for downloading index files from server computer to the user's computer.

6. The prior art made of record

A. U.S. Patent No. 6,334,124

B. U.S. Patent No. 6,546,385

The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

C. U.S. Patent No. 6041323

D. U.S. Patent No. 6490575

E. U.S. Patent No. 6240409

***Response to Arguments***

7. The Applicants' arguments filed on March 18, 2004 have been fully considered, but they are not persuasive, for the Examiner's response, please see discussion below.

a). At Pages 10-11, Concerning rejection of Claims 1 and 4 under 35 U.S.C. 102, Applicants argued Bouchard reference does not teach or suggest "providing the user of the client with a mechanism to individually select the one or more search indices for download onto the client" for rejecting Claim 4. Further, in the Amendment filed on April 8, 2004, the Applicants cancelled Claim 4 and amended its claim body as a new

limitation to Claim 1. Similarly, the Applicants cancelled claims 14 and 24, and amended the claims to independent claims 11 and 21, respectively.

As to the above argument a), the Examiner disagreed because Bouchard reference teaches "the transmitted client indices are stored, or cached, locally at the client computer" and "the client indices may be cached only for each session, or may be kept in a secure manner at the client computer so that retransmission of the client indices will be unnecessary in subsequent sessions" in col. 9, lines 1-6, the section originally cited in the Examiner's non-Final Office Action. Based on the above statements, the transmission and re-transmission of client indices are not done through an automatic process. Further, the user indices "may be cached only for each session" and "locally cached or stored" suggested the transmission and re-transmission is selected by the user and the selection is locally initiated. Further more, the reference teaches transmission of user indices may be session-wise which suggested indices may be selected differently for different sessions.

As further pointed out col. 8, lines 34-67 of the Bouchard reference in the Applicants' argument at Page 11, note the statements "user of a given client computer may have an account that has been authorized access to only a portion of server data repository" (col. 8, lines 34-37) is a very normal practice in the art, and "only references to records for which that user has authorized access will be referenced in the client indices to be transmitted to the client computer" suggested the user can only access the authorized data and its corresponding indices for transmission to the client computer.



As for the rest of the Applicants' made the same arguments for dependent claims (2-3, 5-10), (12-13, 15-20) and (22-23, 25-30), which depend on claims 1, 11 and 21, respectively, the Examiner disagreed by applying the same responses as previously stated in the items a), b) and c).

8. In light of the forgoing arguments, the U.S.C 102 and 103 rejection for Claims 1-3, 5-13, 15-23 and 25-30 are hereby sustained.

### ***Conclusions***

#### **9. THIS ACTION IS MADE FINAL.**

The Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

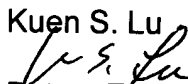
10. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to Applicants' disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is (703) 305-9601 for faster service.

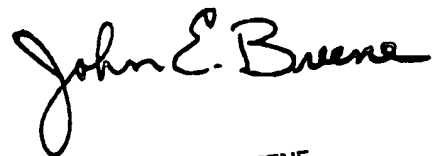
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 703-305-4894. The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Kuen S. Lu  
  
Patent Examiner

June 12, 2004



JOHN BREENE  
SUPERVISORY PATENT EXAMINER  
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